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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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THE NATH LAW GROUP				
112 South West Street				
Alexandria, VA 22314				
EXAMINER				
PIERCE, WILLIAM M				
ART UNIT		PAPER NUMBER		
3711				
MAIL DATE		DELIVERY MODE		
06/23/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/588,999

**Applicant(s)**

TAL, SAPIR

**Examiner**

William M. Pierce

**Art Unit**

3711

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 and 15-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 15-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

**Claim Rejections - 35 USC § 112**

Claim 15, 16, 28-30 and 32 and their dependant claims are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

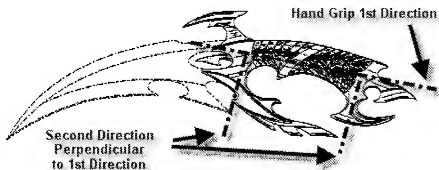
In claim 15, the recitation of a "coat" lacks any recitation of a structural relationship to the other recited elements and the term "sufficient to disguise" is considered indefinite. Sufficiency is a relative term with no definite metes and bounds.

Claims 16 and 28-30 fail to further limit the structure of a previously claimed element and are indefinite in that one cannot determine if a "key ring" and "elongated object" are being claimed in combination. Currently these are referred to only functionally.

In claim 32, "configured sufficient to be used" is indefinite. One cannot determine what structure is required to accomplish this function.

**Claim Rejections - 35 USC § 102**

Claims 1 and 3-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Rae D478,957 as set forth in the previous office action.



Claims 1, 2, 5, 6, 7, 11, 12, 16, 17 and 32, are rejected under 35 U.S.C. 102(b) as being anticipated by Townsend 5,546,832.

Townsend is applied as an alternate rejection to show how the combination of elements and their structural relationship being recited broadly reads on many apparatus.

As to claims 1, 2 and 5-7, Townsend shows a first hand grip portion 48 with finger ridges, a first spike 14 at a first end and second spike 46 at a second end in a same direction, and a third spike 16 opposite the first spike. Here the term spike is most broadly construed to be a protrusion. Applicant's specification offers no specific definition and the plain meaning of the term as "something resembling a very large nail" fail to impart any special meaning to the term such that it should be afforded a narrower interpretation. Element 12 is considered a bulging portion as called for by claim 11 and 36 considered fifth spike as called for by claim 12. The apparatus of Townsend is capable of having a key ring attachable thereto as called for by claim 16 or used as a bag carrier as called for by claim 32.

Claims 2 and 15-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rae in view of matters considered old and well known to striking weapons as set forth in the previous office action.

Claims 3, 15, 17-31 and 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Townsend in view of matters considered old and well known to striking weapons.

As to claim 3, curving a hand grip portion of a tool like that shown by Townsend is considered old and well known in order to make it easier and more comfortable to grip. As to claim 15 applying a coating such as paint to an article such as that shown by Townsend would have been obvious in order to decorated it and protect it from the elements. As to claims 17-26, combining diverse article such as tools, lights and dispersant mechanisms has been held obvious where the two devices perform their intended functions and no synergistic benefit is realized. As such the combination of the apparatus of Townsend with a diverse article such as that being claimed would have been obvious in order to make it more convenient that carrying two separate tools. Wrist straps as called for by claim 27 are old and well known to hand held implements. As to claims 28-30, the apparatus of Townsend is capable of serving as a handle for an elongated object. As to claim 31 and 33, protective covers or cases and belt clip for tools are considered old and well known. As to claims 34-36, providing instructions with a device in how to use it is considered old and well known. Further, it has been

held that the addition of instructions for how to use a device cannot impart patentability. See *In re Ngai* (5/13/04)(*Michel, Garjarsa, Linn*)(*per curiam*)

### **Conclusion**

Applicant's arguments filed 3/30/098 have been fully considered but they are not persuasive as set forth above in the grounds for rejection.

With respect to the application of Rae on pg. 18 of his remarks, applicant emphasizes the "first and third spikes form a second hand grip portion extending only along a second direction generally perpendicular to the first direction". First the term hand grip does not impart any new structure to the claimed apparatus. This term is functional at best only relating to the intended use. While applicant begs to differ that the end portion of Rae cannot function as a grip due to the blades, such is only speculative since knives are known to be gripped by the blade during use such as a throwing. There is nothing in Rae or the prior art that states that his device is not capable of being gripped by the first or third spike or describing them as a "grip portion".

Applicant argues that he examiners annotated 2<sup>nd</sup> direction perpendicular to the 1<sup>st</sup> direction is not "formed by" the 1<sup>st</sup> and 3<sup>rd</sup> spike. This argument is not clear. It appears that applicant takes exception to the figure of Rae where portions the elements considered to be the 1<sup>st</sup> and 3<sup>rd</sup> spikes do not precisely trace the lines drawn by the examiner as being the second direction. However, such an argument is not commensurate with the scope of the claims that recites that the 1st and 3rd spikes extend "in a direction generally perpendicular to the first direction". Here as long as the prior art spike extend in a direction that can be defined as "generally perpendicular",

then this limitation is considered fairly met. The examiner's interpretation does not believe that the language of the claims requires that 1st and 3rd spiked to "extend perpendicularly", only that they extend "in a direction" that is generally perpendicular.

Where applicant states that the definition of spikes implies a "point element" he provides no authority for such a definition or an explicit definition in his specification. Further this definition is not commensurate with applicant's own disclosure where his spikes are not pointy as shown in his fig. 1. In fact, his spikes are more considered to be blunt. Here where the "spikes" are broadly considered to be a protruding element, the extensions of the prior art are considered to meet the limitations recited in the claims with respect to this term.

On pg. 21 of his remarks applicant argues the intended use of the prior art which is unpersuasive since such fails to show where the structure of the elements recited in the claims distinguishes over the applied art. Where applicant again argues that Rae cannot form a second hand grip portion, the examiner disagrees because such is functional and such an apparatus is considered capable of being used as recited in the claims. To say the one "would not be inclined to place or grip their hand upon such a portion" is speculative and not supported by any evidence of record. Here knives are thrown by being gripped by the blade portion or can be gripped by the blade when doing detailed tasks. Here where one may grip any portion of Rae, albeit carefully, his device is considered capable of performing the functional recitations recited in the claim. Applicant argues the rejection of claims 2 and 15-36 by merely asserting patentability and arguing that a prima facie case has not been established. Nowhere are the facts

submitted as old by the examiner refuted. It is well settled that the teachings need not come from within the four corners of the applied art. What must be established to sustain an obviousness rejection is a legally sufficient rationale as to why the claimed subject matter, as a whole, would have been obvious notwithstanding a difference between claimed subject matter and a reference which is prior art under 35 U.S.C. § 102. Once a difference is found to exist, then the examiner must articulate a legally sufficient rationale in support of a §103(a) rejection. The legally sufficient rationale may be supported by a reason, suggestion, teaching or motivation in the prior art which would have rendered obvious the claimed subject within the meaning of § 103(a). Note that motivation can come from 1) the teachings of the prior art, 2) the knowledge of persons of ordinary skill in the art and/or 3) the nature of the problem solved. See *In re Rouffet*, 149 F.3d 1350, 47 USPQ 2<sup>nd</sup> 1453 (Fed. Cir. 1998). Here the features being claimed by applicant are well known in the art of hand held defensive weapons and applicant has applied them to his device for their known and intended purpose.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Pierce whose telephone number is 571-272-4414 and E-mail address is bill.pierce@USPTO.gov. The examiner can normally be reached on Monday and Friday 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, communication via email at the above address may be found more effective. Where current PTO internet usage policy does not permit an examiner to initiate communication via email,



such are at the discretion of the applicant. However, without a written authorization by applicant in place, the USPTO will not respond via Internet e-mail to any Internet correspondence which contains information subject to the confidentiality requirement as set forth in 35 U.S.C. 122. A paper copy of such correspondence will be placed in the appropriate patent application. The following is a sample authorization form which may be used by applicant:

*"Recognizing that Internet communications are not secure, I hereby authorize the USPTO to communicate with me by responding to this inquiry by electronic mail. I understand that a copy of these communications will be made of record in the application file."*

For further assistance examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/William M Pierce/

Primary Examiner, Art Unit 3711